REMARKS

By the present amendment, the specification has been amended, Claims 1, 4, 5, 11, 13, 15 and 17-20 have been amended, and Claims 3, 12 and 16 have been canceled. Claims 1, 2, 4-11, 13-15 and 17-20 remain pending in the present application. Claims 1, 11 and 15 are independent claims.

Applicant respectfully submits that the amendments to the specification and claims are fully supported by the original disclosure, and introduce no new matter therewith. Applicant respectfully requests reconsideration and allowance in view of the foregoing amendments and the following remarks.

Applicant appreciates the courtesies extended to Applicant's representative during the personal interview held September 8, 2005. The present response summarizes the substance of the interview. At the interview Applicant's representative discussed a proposed amendment. Proposed amended independent Claim 1 recited a confirming FAX machine that included means for scanning each page of a document and sending the information scanned electronically to a receiving FAX machine, means for marking each page of a document scanned and sent by the FAX machine with an ink message, the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum, and means for reading the marking to confirm the sending of each page of the document. The FAX machine was configured to confirm that a document has been

completely sent by said FAX machine to a particular receiver at a particular time and date.

Applicant's representative presented arguments traversing the rejection of Claims 1, 11 and 15 under 35 U.S.C. § 102(b) as being anticipated by Kawashima et al. (U.S. Patent No. 5,764,371), the rejection of Claims 2, 12, 13 and 16 are under 35 U.S.C. §103(a) as being unpatentable over Kawashima et al. in view of Liang (U.S. Patent No. 5,867,586), the rejection of Claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Liang and Taylor (Great Britain Patent Application Publication No. GB 2 342 434 A), the rejection of Claims 4 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Liang and Russel (U.S. Patent No. 4,777,510), the rejection of Claims 5, 6, 14 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al. (U.S. Patent No. 5,923,763) and Cooper et al. (U.S. Patent No. 5,465,167), the rejection of Claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al. and Park (U.S. Patent No. 6,522,426), and the rejection of Claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al., Park and Yana (4,590,486). A formal agreement as to the patentability of the claims was withheld by the Examiner pending a thorough review of arguments and proposed amendment presented at the interview, a thorough review of this amendment, and a further update search.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include reference characters 30, 52, 90 and 140 not mentioned in the description. Applicant has amended the specification to include reference characters 30, 52, 90 and 140 indicated on the drawings, and respectfully submits that this objection is overcome.

Claims 6 and 20 are objected to as being substantial duplicates. Applicant has amended Claim 20 to depend from Claim 19, and respectfully submits that the amendment to Claim 20 overcomes this objection.

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Examiner notes that said confirmation device in line 3 of claim 4 lacks antecedent basis. Applicant has amended Claim 4 to delete the phrase "said confirmation device further comprising".

Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 4 under 35 U.S.C. § 112, second paragraph.

Claims 1, 11 and 15 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kawashima et al. Claims 2, 12, 13 and 16 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawashima et al. in view of Liang. Claims 3 and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawashima et al. in view of Liang and Taylor. Claims 4 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawashima et al. in view of Liang and Russel. Claims 5, 6, 14 and 19 are rejected under 35 U.S.C. § 103(a) as

allegedly being unpatentable over Kawashima et al. in view of Walker et al. and Cooper et al. Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al. and Park. Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al., Park and Yana. Applicant respectfully traverses these rejections.

Applicant has revised Claims 1, 4, 5, 11, 13, 15 and 17-20 to more particularly define Applicant's claimed invention in view of the prior art of record.

Amended independent Claim 1 recites a confirming facsimile (FAX) machine including means for scanning and sending each page of a document electronically to a receiving FAX machine, means for marking each page of a document scanned and sent by the FAX machine with an ink message, the ink message being printed with an invisible ink which is only visible in the UV spectrum, and means for reading the marking to confirm the scanning and sending of each page of the document. The FAX machine is configured to confirm that each page of a document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date.

Amended independent Claim 11 recites a method of confirming the scanning and sending of each page of a document by a FAX machine, the method including scanning and sending each page of the document by the FAX machine, marking each page of the document with invisible ink which is only visible in the UV spectrum, reading the

marking to confirm the scanning and sending of each page of the document, and confirming that each page of the document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date.

Amended independent Claim 15 recites a FAX confirmation device including means for marking each page of a document scanned and sent by a FAX machine with an ink message, the ink message being printed with an invisible ink which is only visible in the UV spectrum, and means for reading the marking to confirm the scanning and sending of each page of the document to a particular receiving FAX machine at a particular time and date. The FAX confirmation device is configured to be attached with a FAX machine at a point past the output of a scanner of the FAX machine.

Kawashima et al. describes an image forming apparatus that indicates completion of a scanning operation for both sides of an original document, or completion of a transmitting operation of image information data corresponding to both sides of the original document. The image forming apparatus scans both sides of the original document for obtaining the image information data. A first marker unit provides a first mark when a scanning of a front side of the original document is completed or when a transmission of image information data corresponding to the front side is completed. A second marker unit provides a second mark when a scanning of a reverse side of the original document is completed or when a transmission of image information data corresponding to the reverse side is completed.

Liang describes an authentication system that combines a source of ultraviolet light (and optionally a scanning mechanism) with apparatus for capturing and recognizing either graphic images or characters or both, where the graphic images and/or characters have been previously made with fluorescent substances that may be invisible under ordinary visible light, but are rendered detectable by the ultraviolet light. As in conventional optical character recognition (OCR), the characters may be conventional alphanumeric characters readable by human readers once they are made visible. The authentication system has a housing enclosing its optical path, a source of UV light, a detector for detecting graphic images or characters, conversion of the detector signal to digital form, a memory storing predetermined indicia, recognition logic, and indicating means. The system may also include a scanning mechanism and optical filters to select predetermined wavelengths of fluorescent light. The detector may be capable of detecting both fluorescent images and normal visible images, and the authentication system may incorporate switching mechanisms to allow multiplexed acquisition of fluorescent and normally visible images. The authentication system can operate in conjunction with a process for marking articles with indicia selected from a predetermined set of graphic images and characters readable by optical character recognition and/or by image comparison. That process can include printing fluorescent graphic images or characters in registration with (or with predetermined offset from) visible images or characters or indicia printed with substances fluorescent at different wavelengths. The recognition logic of the authentication system can include comparison

of fluorescent and visible images or two different fluorescent images with each other. Pairs of indicia to be recognized and/or compared may be arranged to constitute a stereogram or other arrangement for first-order authentication by a human observer.

Taylor describes a portable UV light that has a source of electrical power, a source of UV light and electrical/electronic means to connect the source of UV light to the source of power and convert it to a form suitable to operate the source of UV light. A miniature UV bulb or LED and internal battery power are taught. The miniature bulb is preferably of the low voltage (20-30V) type. External power sources, as back-ups, are also disclosed. Optical means to focus and filter the light output are taught. A preferred design is a light pen to fit in a pocket with other pens and is operated by using the clip as the switch. Further means of miniaturization are disclosed. The light may be used for detecting forged banknotes, documents, etc., identifying stolen goods and for medical or scientific purposes, etc.

Russel describes an apparatus and method for producing color-accented or otherwise edited reproductions of original documents with high productivity. Information of originals to be reproduced with, for example, color-accenting are highlighted on the originals with a marker pen or encircled with the highlight. The highlighted originals are serially passed during a copy run over an image scanner that is sensitive to the highlighted portions. The locations of the highlighted portions for each original are detected and stored in a bit map. In one embodiment an original is imaged onto two image frames of an electrostatically charged photoconductor. The

photoconductor not being capable of distinguishing highlighted areas from background reproduces the electrostatic images through an optical exposure as if no highlighting is present. A selective erase element is provided to erase from one frame, areas on the original that were highlighted and to erase from the other frame, areas on the original that were not highlighted. The image frames are developed, each with a differently colored toner, and the developed areas transferred in register to a copy sheet to provide a reproduction with color accenting. In another embodiment the information is electronically scanned onto the photoconductor using an LED or laser light source and the appropriate image frames exposed in accordance with the highlighting on the documents. Highlighting of an original may also be used to indicate areas to be selectively screened, filled with a screen tint, areas to be deleted, or areas to be repositioned.

Walker et al. describes devices and methods for creating a cryptographically assured timestamp that can be verified by a party that was not present during the creation of the timestamp. The timestamp is applied to physical documents, and other substrates capable of receiving an optically detectable mark, that are to be transmitted to temporally or spatially distant recipients.

Cooper et al. describes how a page is automatically created and transmitted in response to data defining set of images. The data defines an image showing a form that has been marked; the data also include information indicating an image destination. The page includes a segment that is a version of an image from the marked form. The page

can be another form, a cover sheet, or an error sheet, for example. The segment can be a reduced version of the marked form, such as on an error sheet. Or the segment can be a version of the contents of a field in the marked form, such as on a form, a cover sheet, or a listing sheet. The field can be a cover note field, and if the processor determines that the cover note field has been marked, it can automatically create a cover sheet that includes a segment that is a version of an image of the cover note field. The field can be an identifier field. The processor can create a form with a request field that includes a segment that is a version of an image of the identifier field, identifying an item in relation to which an operation can be requested, such as the recipient of facsimile transmission or a document being facsimile transmitted; or the processor can create a cover sheet with a segment that is a version of an image of the identifier field; or the processor can create a listing sheet in which each item's entry includes a segment that is a version of an image of the item's identifier field. The image destination can be indicated by a check mark in a recipient field, by check marks indicating the telephone number of a fax machine, or by data from a transmitting fax machine indicating the fax machine's telephone number

Park describes a method for printing identification codes of a scanning and printing system. When a document is scanned, an identification code indicating that the document has been scanned is printed at a predetermined position on the document in correspondence to a stored count value. When the document has been completely scanned, the count value is increased by 1, and the increased count value is stored again. Then, when a scanning function is selected again and the document is scanned, the

identification code is printed at another predetermined position of the document corresponding to the newly stored count value. Thus, the printed positions of the identification codes are set to be varied in correspondence to the count value.

Yana describes a thermal ink transfer printing apparatus that has a carriage moved along the rotating shaft of a platen roller, and a thermal head provided with a row of heating elements. A fixture which is urged backward by a spring is rotatably attached to the carriage and to the front side of which is attached the thermal head. A solenoid is fixed on the carriage with its core rod contacted with the backside of the fixture. An ink ribbon fed from an ink ribbon feeding reel and wound around an ink ribbon reel after passing through the thermal head. The ink ribbon feeding and winding reels are arranged on the carriage. When current is applied to the solenoid, the thermal head is pressed against the platen roller to closely contact the ink ribbon with a recording sheet on the circumference of the platen roller, while when current supply is stopped to the solenoid, the thermal head is retreated to peel off the ink ribbon from the recording sheet. When blanks corresponding to two serial characters are applied to the thermal head, both of current supply to the solenoid and the winding of the ink ribbon are stopped, to thereby avoid the winding of the ink ribbon unused.

It is well known that for a reference to anticipate a claim under 35 U.S.C. § 102(b) there "must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention" (see *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, 1010 (Fed.

Cir. 1991). It is also well known that in order to establish a prima facie case of obviousness, all of the claimed limitations must be taught or suggested by the prior art, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. *In re Vaek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that Kawashima et al., Liang, Taylor, Russel, Walker et al., Cooper et al., Park, Yana, or any combination thereof fails to reasonably teach and/or provides no motivation whatsoever to modify the teachings thereof to provide a confirming facsimile (FAX) machine including means for scanning and sending each page of a document electronically to a receiving FAX machine; means for marking each page of a document scanned and sent by the FAX machine with an ink message, the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum; and means for reading the marking to confirm the scanning and sending of each page of the document, wherein the FAX machine is configured to confirm that each page of a document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date, as Claims 1, 2 and 4-10 require.

Applicant also respectfully submits that Kawashima et al., Liang, Taylor, Russel, Walker et al., Cooper et al., Park, Yana, or any combination thereof fails to reasonably teach and/or provides no motivation whatsoever to modify the teachings thereof to

provide a method of confirming the scanning and sending of each page of a document by a FAX machine, the method including scanning and sending each page of the document by the FAX machine; marking each page of the document with invisible ink which is only visible in the ultra violet (UV) spectrum; and reading the marking to confirm the scanning and sending of each page of the document and confirming that each page of the document has been scanned and sent by the FAX machine to a particular receiving FAX machine at a particular time and date, as Claims 11, 13 and 14 require.

Applicant also respectfully submits that Kawashima et al., Liang, Taylor, Russel, Walker et al., Cooper et al., Park, Yana, or any combination thereof fails to reasonably teach and/or provides no motivation whatsoever to modify the teachings thereof to provide a facsimile (FAX) confirmation device including means for marking each page of a document scanned and sent by a FAX machine with an ink message, the ink message being printed with an invisible ink which is only visible in the ultra violet (UV) spectrum; and means for reading the marking to confirm the scanning and sending of each page of the document to a particular receiving FAX machine at a particular time and date, wherein the FAX confirmation device is configured to be attached with a FAX machine at a point past the output of a scanner of the FAX machine, as Claims 15 and 17-20 require.

Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1, 11 and 15 under 35 U.S.C. § 102(b) as being anticipated by Kawashima et al., the rejection of Claims 2, 12, 13 and 16 under 35 U.S.C. § 103(a) as being unpatentable

over Kawashima et al. in view of Liang, the rejection of Claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Liang and Taylor, the rejection of Claims 4 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Liang and Russel (U.S. Patent No. 4,777,510), the rejection of Claims 5, 6, 14 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al. and Cooper et al., the rejection of Claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al. and Park, and the rejection of Claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Kawashima et al. in view of Walker et al., Cooper et al., Park and Yana.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

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